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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,223	10/28/2003	Perriann M. Holden	810101-3	4944
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JERRY RICHARD POTTS 3248 VIA RIBERA ESCONDIDO, CA 92029			EXAMINER HOEY, ALISSA L	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/695,223

Applicant(s)

HOLDEN, PERRIANN M.

Examiner

Alissa L. Hoey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4, 19, 20, 30, 31 and 36-56 is/are pending in the application.
- 4a) Of the above claim(s) 4, 19, 20, 30, 31, 39-45, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-38 and 46-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This is in response to amendment received on 07/17/07. Claim 36 was amended and claim 56 was newly added. Claim 56 is withdrawn as being distinct from the invention originally claimed and as described below. Claims 36-38 and 46-54 are finally rejected below.

### ***Election/Restrictions***

2. Newly submitted claim 56 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 56 requires a dual layered adhesive. Pending independent claims 36 and 52 do not require any adhesive layer. Further, claim 56 requires a hard shell ground contacting protective base, which is not required in claims 36 and 52. The only discussion in the previously filed claims on the adhesive layer was in dependent claim 38, which called for a (single) adhesive layer. The only discussion in the previously filed claims on the protective shell was in dependent claims 38 and 53, which call for a protective shell, but did not detail a hard protective shell.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 56 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the pad being provided with inserts to facilitate exerting pressure points on the skin area of a user (claim 47) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

*Examiner notes that 15A in the figures pointing to a single insert, not plural inserts.*

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 36-38 and 52-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori (US 4,553,550).

In regard to claim 36, Hattori teaches a protective attachment comprising a pad (3) formed of a shock absorbing cushioning material attached to the users skin (see figures). The pad (3) including a top surface (5) and a bottom surface (10). The bottom surface is at least partially covered with a layer of thistle cloth (10) to facilitate removably adhering a complimentary layer of thistle cloth (8) on a ground contacting protective base (1).

In regard to claims 37 and 53, Hattori teaches the protective base is a protective shell to protect the skin area of a user from direct contact with the ground (figures 1-42).

In regard to claims 38 and 54, Hattori teaches the top surface being completely covered with a layer of adhesive (column 7, lines 31-63).

In regard to claim 52, Hattori teaches a protective attachment comprising a first layer of a shock absorbing cushioning material (3) having a top surface (5) and a bottom surface (10). The bottom surface is at least partially covered with a layer of thistle cloth (10). A ground contacting protective base (1) having an inner surface at least partially

covered with another layer of thistle cloth (8) to facilitate removably attaching said ground contacting protective base to the bottom surface.

6. Claims 36, 37 and 48-51 are rejected under 35 U.S.C. 102(b) as being anticipated by Mogonye (US 4,924,608).

In regard to claim 36, Mogonye teaches a protective attachment comprising a pad (12) formed of a shock absorbing cushioning material that is capable of engaging the skin. The pad including a top surface and a bottom surface. The bottom surface is at least partially covered with a layer of thistle cloth (18, 20) to facilitate removably adhering a complimentary layer of thistle cloth (21) on a ground contacting protective base (21).

In regard to claim 37, Mogonye teaches the protective base (21) being a protective shell to protect the skin area of a user from direct contact with the ground (column 2, lines 58-63). (any material can be a protective shell). The protective shell of 21 is located between the user's skin on the foot and the ground so layer 21 protects the skin area from direct contact with the ground.

In regard to claim 48, Mogonye teaches the pad is provided with a raised arch area (column 3, lines 59-60).

In regard to claim 49, Mogonye teaches the ground contacting protective base is a protective foot base (column 2, lines 58-63).

In regard to claim 50, Mogonye teaches the ground contacting base having a bottom surface with a sufficiently durable and flexible character so as to withstand

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ground contact wear caused by the bottom surface making direct contact with a ground surface (column 2, lines 58-60).

In regard to claim 51, Mogonye teaches the pad has an inner cushioned area with an outer adhesive strip which surrounds said cushioned area (column 3, lines 66-68).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by McCrane (US 6,029,273).

In regard to claim 36, McCrane teaches a protective attachment comprising a pad (18) formed of a shock absorbing cushioning material (column 4, lines 13-16) That engages the skin when not worn with pants that extend below the knee. The pad (18) including a top surface and a bottom surface. The bottom surface is at least partially covered with a layer of thistle cloth (22) to facilitate removably adhering a complimentary layer of thistle cloth (22) on a ground contacting protective base (20).

In regard to claim 37, McCrane teaches said protective base (20) being a protective shell to protect the skin area of a user from direct contact with the ground (column 4, lines 26-38).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCrane in view of Humphreys (US 5,233,768).

McCrane teaches a cushioning device as described above in claim 36. However, McCrane fails to teach the cushioning device comprising a magnetic material.

In regard to claim 46, Humphreys teaches an insole with a cushioning device comprising magnetic material (figures 2 and 3: column 1, lines 42-47).

It would have been obvious to have provided the cushioning device of McCrane with the magnetic material of Humphreys, since the cushioning device of McCrane provided with magnetic material would provide a cushioning device that also polarizes the cells in the feet and legs of the wearer to increase the affinity of the blood to oxygen and thereby increasing the strength of the person using the device.

11. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mogonye in view of Buchsenschuss (US 5,664,342).

Mogonye teaches a cushioning device as described above in claims 36 and 37. However, Mogonye fails to teach the pad being provided with inserts to facilitate exerting pressure points on the skin area of a user.



In regard to claim 47, Buchsensschuss teaches an insole provided with inserts to facilitate exerting pressure points on the skin area of a user (see figures 1-4, identifiers 2a).

It would have been obvious to have provided the insole device of Mogonye with the massaging inserts on insole of Buchsensschuss, since the insole device of Mogonye provided with massaging inserts would provide for a footwear garment that provides the therapeutic effect of stimulating the blood circulation in the foot tissue and to influence the functions of certain internal organs.

### ***Response to Arguments***

12. Applicant's arguments filed 07/17/07 have been fully considered but they are not persuasive.

1) Applicant argues that a "protective shell" is something that is intended to "protect against injury" and not merely an article of personal wear for covering the body of the user.

Further, Applicant argues that Hattori fails to teach "a pad of shock absorbing material".

Examiner disagrees since a protective shell is any article that protects against injury. Any fabric/material, no matter what thickness or size provides some degree of protection to the user. There are many different types and degrees of injury, therefore the base of Hattori (1) provides protection to the user's skin, when worn, from injury (example is sun exposure, bug bites, wind burn, ground abrasion, bumping into items etc.).

With respect to the pad of Hattori (3) being formed of a shock absorbing material, Examiner notes that all fabric/material provides some degree of shock absorption and therefore Hattori provides a shock absorbing material (3).

II) Applicant argues that "a protective base" being a garment item would not "protect the skin area of a user from direct contact with the ground".

Examiner disagrees, since garments are well known to provide protection to the user's skin underneath. If one was to fall on the ground a garment protects the user's skin more so than if no material was located between the skin and the ground. Applicant notes that a shell does not automatically imply that it is made out of a specific material. Shell's when used in the apparel industry denote a layer of material/fabric.

III) Applicant argues that the Mogonye (US 4,924,608) fails to teach "wherein said bottom surface is at least partially covered with a layer of thistle cloth to facilitate removably adhering to a complimentary layer of thistle cloth on a ground contacting base.

Examiner notes that hook and loop fasteners and thistle cloth are both names used to denote a hook and loop fastening material. The hooks 18 on fastener 20 of Mogonye is the one part of the thistle cloth fastener and the top layer of 21 is the corresponding loops to attach to the hooks of 18. The hooks 18 and the top loop layer of 21 are the thistle cloth layers. There is no requirement for the layer of thistle cloth to be separate and distinct from the ground contacting base portion.

IV) Applicant argues that Mogonye fails to teach the protective shell (21) protecting the skin area of a user from direct contact with the ground.

Examiner notes that the protective shell layer 21 protects the skin of the user's feet from within the shoe from contacting the ground.

V) Applicant argues that Mogonye fails to teach an adhesive strip which surrounds the cushioning area.

Examiner notes that Mogonye teaches an adhesive that covers the entire cushioning material, which inherently would be considered a strip that surrounds the outer cushioning area, since the cushioning area is still surrounded by the adhesive. Just because the adhesive covers the cushioning area, does not mean that the adhesive strip does not surround the outer cushioning area.

VI) Applicant argues that McCrane fails to teach "a skin adhering pad formed of a shock absorbing cushioning material".

Examiner notes that "a skin adhering pad formed of a shock absorbing cushioning material" is not a limitation in claims 36 and 37, which McCrane is used to reject.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and can be found cited in PTO-892 form submitted herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (571) 272-4985. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALH

/Alissa L. Hoey/  
Primary Examiner, Art Unit 3765